

Appl. No. : 10/811,784
Filed : March 29, 2004

REMARKS

In response to the Office Action mailed June 6, 2005 and the personal interview conducted on June 21, 2005, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments. As a result of the amendments listed above, Claims 11, 15, 16, 20 and 21 remain pending. Claims 1, 5, 6, 10, 12-14 and 17-19 have been canceled, without prejudice or disclaimer. Claims 11, 16 and 21 have been amended. New Claims 22-28 have been added.

In the changes made by the current amendment, ~~deletions are shown by strikethrough~~, and additions are underlined.

Information Disclosure Statement

In the outstanding Office Action, the Examiner indicated that the IDS filed May 13, 2005 has not been considered because it fails to comply with 37 C.F.R. § 1.98(a)(2) for failing to include a copy of each cited foreign patent document or non-patent publication.

Applicant respectfully submits that copies of reference numbers 33 and 34 were not filed because they were of record in the parent application, which is relied upon for an earlier effective filing date in the present application. Thus, Applicant submits that copies of the foreign references were not required in accordance with 37 C.F.R. § 1.98(d). However, for the convenience of the Examiner, copies of reference numbers 33 and 34 have been included in the IDS filed herewith.

In view of M.P.E.P. § 2001.06(c), Applicant has included a copy of an Order Denying Motion for Sanctions in Case No. CV 05-00486 DDP (PJWx) in the United States District Court for the Central District of California. This case is a patent infringement dispute involving U.S. Patent No. 6,722,678, which issued from the parent of the present application.

Claim Rejections Under 35 U.S.C. § 112

Claims 12, 13, 17 and 18 presently stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states that a bleed valve cannot be found in the specification or drawings. Applicant respectfully submits that at least Figure 7 provides support for Claims 12, 13, 17 and 18. However, because

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the present application is currently under final rejection, Applicant has canceled Claims 12, 13, 17 and 18, without prejudice or disclaimer. Applicant reserves the right to pursue the same, or similar, claims at a later date through continuation practice.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1, 5, 6, 10, 11, 15, 16, 20 and 21 presently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Girvin in view of Gatter. Claims 1, 5, 6 and 10 have been canceled, without prejudice or disclaimer. Claim 11 has been amended to incorporate the limitations of allowable Claim 14 and Claim 16 has been amended to incorporate the limitations of allowable Claim 19. Claims 15 and 20 are allowable because they depend from allowable Claims 11 and 16, respectively, and are also allowable on their own merit. As discussed above in the Summary of the Interview section, the Examiner agreed that the proposed amendment to Claim 21 would render the claim allowable over the prior art of record.

New Claims 22-28 Have Been Added

New Claims 22-28 have been added and are fully supported by the application as filed. Claims 22 and 23 depend from Claim 21 and are allowable not only because they depend from an allowable claim, but upon their own merit as well. New Claim 24 was discussed and deemed allowable during the personal interview with the Examiner on June 21, 2005. Claims 25-28 depend from Claim 24 and are allowable not only because they depend from an allowable claim, but upon their own merit as well.

Applicant notes that the phrase "to prevent significant compressive movement" recited in Claim 24 should be construed in accordance with its plain meaning. That is, the phrase "to prevent significant compressive movement" is entitled to the ordinary and customary meaning attributed to it by those of ordinary skill in the art. See M.P.E.P. § 2111.02. Thus, although the non-limiting embodiment of Figures 3-6 preferably is configured to substantially prevent fluid flow from chamber 314 to chamber 332 when the inertia valve is in a closed position, Claim 24 is not limited to such a construction. In certain arrangements, fluid flow may be permitted from chamber 314 to chamber 332 when the inertia valve is in a closed position and the suspension assembly may still prevent significant compressive movement in response to rider-induced

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pedaling forces. For example, paragraph [0028] of the present application clearly states that, in the closed position of the inertia valve, fluid flow between chamber 314 and chamber 332 may be blocked or reduced.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims and specification. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Edward A. Schlatter at (949) 721-2821 (direct line), to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 24, 2005

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